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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,651	12/19/2005	Martin Klare	23432	7841

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT PAPER NUMBER

1752

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/561,651

Applicant(s)

KLARE ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 1, line 2 is found “for stereo” as an intended use, but applicants do not make clear what is meant by “stereo”. Is it stereolithography or is it in reference to an earpiece and the use of the earpiece to listen to “stereo”? Since the intended use of “for expecially stereo” has some limitation, i.e. the composition has to have the ability to some how perform the intended use in some fashion, then the meaning of ‘stereo’ is critical to understanding the limits of the instant invention. Without definition and with the use of the term stereolithography in the specification, this examiner cannot determine if a word has been shortened, or that “lithography” was forgotten, etc. Thus, claims 1-2 are found indefinite.

- b. In line 5 of claim 1 is found “...weight percent of ... on the basis of bisphenol-A or bisphenol-F...”. Is weight percent 55 to 95% of the bisphenol present? Is this weight percent referencing the amount of monomer or oligomer is bisphenol-A or bisphenol-F? Does “on the basis” reference the kind of dimethacrylate being used? Is the weight percentage as set forth in the last three lines of claim1 and “whereby the proportion of the

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components a to h together amounts to 100%”? This “on the basis” is confusing for this reason.

c. Does “whereby the proportion of the components a to h together amounts to 100%” exclude all other components from the “biocompatible, low viscosity, radiation curable formulation or does it mean that consider only these components a to h when considering what is meant by 100% for the weight percentages given. The use of “comprising “ in line 3 of claim 1 indicates open language thus open to other components outside a through h. Thus, this wording is confusing.

d. With respect to line 16 in claim 1 and line 17 in claim 2, what is meant by “(free radical)” ?

e. In claim 2, lines 2-5, what is meant by n-fold is unclear leaving unclear what is meant  $n < 10$ . What is meant by “ethyloxilation” is unclear as well. The examiner has never seen this term and notes that applicants reference on page 10 at the top “ethoxylation”. Does the degree reference all the ethoxy groups present or just those between one end of the bisphenol and the acrylate group on each side of the molecule? Thus, claim 2 is confusing.

f. What is meant by “a sensitivity of  $n < 4$ ” in line 7 of claim 2 in reference to an aliphatic or cycloaliphatic urethane methacrylate?

g. In lines 9-10 of claim 2, what is meant by “with and a” in reference to the dimethacrylate”?

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h. With respect to claims 1-2, reference after e) is made to “the laser beam used”.

There is no clear antecedent basis for “the laser beam” thus what limit is set forth here is unclear.

For these reasons claims 1-2 are found confusing and vague and thus indefinite with respect to the metes and bounds of what is being claimed.

4. The examiner notes for the record that “like uv stabilizers or flow additives” is not a claim limitation and “especially for stereo, for use in medicinal technology, especially for producing earpieces” appears to be a list of possible uses for the instant “biocompatible, low viscosity, radiation curable formulation” and not a single use to which the composition is to be put and thus any one use does not limit the formulation as these appear to be only preferred uses and not a requirement needing to be met by the formulation. The examiner takes “usual additives” to mean any additives as they are not defined and are inclusive of the already listed fillers, inhibitors, color pigments as well as the “like uv stabilizers or flow additives” along with levelers, solvents, etc.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Popat et al (6,025,114) teach stereolithographic molding with compositions comprising 20 to 80 % ethoxylated bisphenoldimethacrylates but there is no indication of using the monomers of required viscosity. Rheinberger et al (5,354,785), Neubert et al (2002/0152930 A1) and Yang et al (5,969,000) teach similar compositions used in dental materials. Sartomer Application Bulletin “Chemical Intermediates – Design Unique Polymers with Sartomer's Specialty Monomers” show on page 3 commercial ethoxylated bisphenol A dimethacrylates. Itsuki et al (JP 2002-302523 A and machine English translation thereof) teach molding hearing


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aids with photocurable compositions with bisphenol A EO adduct diacrylates. The examiner found no compositions which made the instant composition obvious or anticipated.

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.*

*Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.*

  
**CYNTHIA HAMILTON**  
**PRIMARY EXAMINER**

Cynthia Hamilton  
Primary Examiner  
Art Unit 1752

September 30, 2006

**CYNTHIA HAMILTON**  
**PRIMARY EXAMINER**